HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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PATENT APPLICATION
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ATTORNEY DOCKET NO. 10981001-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Sandra L. Standiford et al.

Confirmation No.: 5929

Application No.: 09/368,792

Examiner: T. Q. Tran

Filing Date: 08-05-1999

Group Art Unit: 2615

Title: VIDEO DATA CONVERSION MECHANISM

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Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith in **triplicate** is the Appeal Brief in this application with respect to the Notice of Appeal filed on 02-13-2004.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) $330.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

( ) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

( )	one month	$110.00
( )	two months	$420.00
( )	three months	$950.00
( )	four months	$1480.00

( ) The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of **$330.00**. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Signature: Christopher S.L. Crawford

Respectfully submitted,

Sandra L. Standiford et al.

By Christopher S.L. Crawford

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Rev 10/03 (Aplbrief)

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4-20-04
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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

Docket No.: 10981001-1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Sandra L. Standiford et al.

Application No.: 09/368,792 Confirmation No.: 5929

Filed: August 5, 1999 Art Unit: 2615

For: VIDEO DATA CONVERSION MECHANISM Examiner: T. Q. Tran

APPELLANT'S BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This brief is in furtherance of the Notice of Appeal, filed in this case on February 13, 2004.

The fees required under § 1.17(f) and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate.

This brief contains items under the following headings as required by 37 C.F.R. § 1.192 and M.P.E.P. § 1206:

I. Real Party In Interest
II Related Appeals and Interferences
III. Status of Claims
IV. Status of Amendments
V. Summary of Invention
VI. Issues
VII. Grouping of Claims

The final page of this brief bears the attorney's signature.

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is: Hewlett-Packard Development Company, a Texas Limited Liability Partnership having its principal place of business in Houston, Texas.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 20 claims pending in application, identified as claims 1-20.

B. Current Status of Claims

1. Claims canceled: None

2. Claims withdrawn from consideration but not canceled: None

3. Claims pending: 1-20

4. Claims allowed: None

5. Claims rejected: 1-20

C. Claims On Appeal

The claims on appeal are claims 1-20.

IV. STATUS OF AMENDMENTS

Appellant has filed no responses to the Final Rejection mailed December 16, 2003. No amendments have been made after the Final Rejection.

V. SUMMARY OF INVENTION

The inventive mechanism would allow a user to transfer data from an original format such as VHS or digital video to an optical media such as a CD-R (read-only Compact Disc), CD-RW (Read/Write Compact Disc) or DVD-RW (Read/Write Digital Video Disc) and prepare it for use in non-linear computer applications, such as video editing and production, in a single step conversion process.

The inventive mechanism (10 of the sole Figure) has an input slot (11 of the sole Figure) to receive a video tape (12 of the sole Figure). (See also page 7, line 1 of the specification.) The inventive mechanism would then convert the video data on the video tape into digital video data, and insert index markers at scene changes in the video data. The inventive mechanism would then store the digital data onto CD or DVD discs (14 of the sole Figure), as selected by the user. Note that since one video tape typically holds two hours of video data and one CD disc will hold one hour of video data, the inventive mechanism preferably has slots to hold two CD discs. This will allow for transfer onto CD disc without having to prompt the user to replace the CD disc with a blank CD disc. After transfer, the user could then insert the CD or DVD disc(s) into a computer for additional processing. The video disc has the data stored in a standard format such as MPEG-1, MPEG-2 or other, still to be developed format, and thus would be compatible with most computer systems.

Preferably, the inventive mechanism operates without much user intervention. The user would insert the source tape, either one or two CD-RW discs or one DVD-RW disc. The inventive mechanism would then begin to automatically process the data from the source tape. Alternatively, the inventive mechanism would have standard video input connectors. These connectors would allow the inventive mechanism to be connected directly to a video player such as a VCR machine. Thus, the inventive mechanism would utilize the external tape player as the source for the video information.

In a preferred embodiment, the inventive mechanism will also insert index markers into the video data. (See also page 8, line 21 of the specification). The markers could be time based, e.g. every real time ten minutes of video data a marker is inserted. The inventive mechanism could also insert markers based on scene changes, including content changes such as people, buildings, and the like. The inventive mechanism would analyze the video data and determine when the video data has switched to a different scene or segment, and would insert a marker at the transition point. The inventive mechanism can also insert markers based on both time and scene. The user would be able to select and enter the appropriate marker information via, a user interface, e.g. a key pad or control pad.

VI. ISSUES

The issues remaining are:

(1) whether claims 10-11 and 14-19 are patentable over the rejection under 35 U.S.C. § 103(a) with Dunlap et al. (U.S. Patent number 5,216,552, hereinafter Dunlap) in view of Yamamoto (U.S. Patent number 4,355,338); and

(2) whether claims 1-9, 12-13, and 20 are patentable over the rejection under 35 U.S.C. § 103(a) with Dunlap in view of Yamamoto, and further in view of Tognazzini (U.S. Patent number 6,263,147).

VII. GROUPING OF CLAIMS

For purposes of this Appeal Brief only, the claims have been grouped as follows:

Group I: Claims 10-11 and 14-19

Group II: Claims 1-9, 12-13, and 20

The claims do not stand or fall as a group. In Section VIII below, Appellant has included arguments supporting the separate patentability of each claim group.

VIII. ARGUMENTS

A. Rejections Under 35 U.S.C. § 103

1. Rejection of claims 10-11 and 14-19 under 35 U.S.C. § 103(a) as being unpatentable over Dunlap et al. in view of Yamamoto.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Without conceding the second and third criteria, Appellant asserts that the rejection does not satisfy the first criteria.

Lack of Motivation

In the First Office Action, dated June 19, 2003, the Examiner admits that Dunlap does not teach having an analog to digital converter for converting said analog video output into digital and at least one recorder employing a digital storage medium. The Examiner attempted to cure this deficiency by introducing Yamamoto, which the Examiner alleged to teach having such elements. The motivation for making the combination was presented as follows:

> "It would have obvious ... to incorporate the A-D converter 9 and disc recorder 13 as taught by Yamamoto et al into Dunlap et al's system in order to increase the quality of the video signal to be duplicated."

In the Response dated September 16, 2003, Appellant pointed out, that it is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. Using a digital converter will not affect the quality of the video signal that is to be duplicated. In other words the video signal is not changed by adding a digital converter. Moreover, in comparing the analog signal with the converted digital signal, by definition, the converted digital signal has less information than the analog signal, and thus the digital signal is of less quality than the analog signal. Furthermore, Appellant asserted that Dunlap will not benefit from the teachings of

Yamamoto. Yamamoto addresses tape degradation that occurs in mass production of tapes. Over time, a master tape will degrade from being replayed at high speed for many times, see column 1, lines 54-63 of Yamamoto. Dunlap is directed to a consumer electronic device, and thus does not involve the mass production of tapes using high speed duplication. Thus, Dunlap will not experience the problems that are solved by Yamamoto, and consequently, there is no desirability to incorporate Yamamoto into Dunlap. The language of the stated motivation is then merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

In the Final Office Action of December 16, 2003, the Examiner reasserted this rejection, and responded to the arguments of the Appellant by stating that the Appellant is attacking the references individually and that non-obviousness cannot be shown from such an attack.

In response, the Appellant notes that the references have not been attacked individually, but rather the attempted combination of the two references has been attacked.

Also in the Final Office Action, the Examiner points to column 3, lines 38-48 and column 4, lines 46-64 of Dunlap, and states that Dunlap teaches the dubbing a video signal from one tape to another tape. The Examiner then points to column 1, lines 54-63 of Yamamoto which teaches that using a digital master tape avoids the problems of using an analog master tape, namely damage from reuse in making copies. The Examiner states that these sections teach an increase in the quality of the video signal by using a digital form.

In response, the Appellant notes that the Examiner's belief is misplaced, in that these sections do not support the stated motivation. As stated Appellant stated earlier, Dunlap is a consumer electronic device and does not reuse the master tape the 1000's of times that Yamamoto would reuse the master tape. Thus, Dunlap will not have the same problems as Yamamoto. Moreover, the increase in quality that is achieved in Yamamoto comes not at the

conversion of the analog master into the digital master, but rather during the making the analog duplicates of the digital master. Thus, the increase in quality is in the recording of the analog duplicate tapes, not in the recording of the digital master. Thus, these statements do not support the previously supplied motivation, nor do these statements themselves provide motivation for combining Dunlap and Yamamoto.

No valid suggestion has been made as to why a combination of Dunlap and Yamamoto is desirable. Therefore, the rejection of claims 10-11 and 14-19 is respectfully requested to be reversed.

2. Rejection of claims 1-9, 12-13, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Dunlap et al. in view of Yamamoto, and further in view of Tognazzini.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Without conceding the second criteria, Appellant asserts that the rejection does not satisfy the first and third criteria.

Lack of Motivation

The lack of motivation arguments made above with regard to the rejection over Dunlap in view of Yamamoto apply in this rejection as well; however, these arguments will not be repeated here for the sake of brevity. The inclusion of Tognazzini as well as the motivation used to combine Tognazzini with the combination of Dunlap and Yamamoto does not cure the deficiency in the motivation used to combine Dunlap and Yamamoto.

No valid suggestion has been made as to why a combination of Dunlap, Yamamoto, and Tognazzini is desirable. Therefore, the rejection of claims 1-9, 12-13, and 20 is respectfully requested to be reversed.

Lack of Claimed Elements

The Office Action admits that the combination of Dunlap and Yamamoto does not teach having a key frame marker for inserting at least one marker into the digital data. The Office Action attempts to cure this deficiency by introducing Tognazzini, which the Office Action alleges to teach having such elements. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claim 1 recites **a key frame marker for inserting at least one marker into the digital data** (emphasis added). Tognazzini is directed to the recording of a program or a scene from the beginning, after the program or scene has started. *See* abstract of Tognazzini. Tognazzini does not insert at least one marker into the digital data. Therefore, the Appellant respectfully assert that for the above reasons claim 1 is patentable over the 35 U.S.C. § 103(a) rejection of record.

In the Final Office Action, the Examiner asserts that column 7, lines 20-59 of Tognazzini teaches adding pointers to the digital signal, and that these pointers read on the claimed limitation.

In response, Appellant notes that this section of Tognazzini discusses the flowchart of Figure 7. This section teaches setting pointers to mark memory locations (block 720). The pointers are stored separately from the digital data, as the pointers are erased when the corresponding memory location is overwritten (block 724). In claim 1, the digital data results from the conversion of the analog video output, and the digital data is stored in a digital storage medium, and the key frame marker inserts at least one marker into the digital data. In other words, the key frame marker inserts at least one marker into the digital data converted from the analog signal. Tognazzini does not disclose inserting a marker into the digital data as required by claim 1.

Claims 2-9 depend directly from base claim 1, and thus inherit all limitations of claim 1. Each of claims 2-9 sets forth features and limitations not recited by the combination of Dunlap, Yamamoto, and Tognazzini. Thus, the Appellant respectfully assert that for the above reasons claims 2-9 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 12 depends from claim 10 and defines inserting at least one marker in said digital video data to identify abrupt changes in video scenery. Tognazzini is directed to the recording of a program or a scene from the beginning, after the program or scene has started. Tognazzini does not insert at least one marker into the digital data. Therefore, the Appellant respectfully assert that for the above reasons claim 12 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 13 depends from claim 10 and defines inserting at least one marker in said digital video data at selectable time intervals. Tognazzini is directed to the recording of a program or a scene from the beginning, after the program or scene has started. Tognazzini does not insert at least one marker into the digital data. Therefore, the Appellant respectfully assert that for the above reasons claim 13 is patentable over the 35 U.S.C. § 103(a) rejection of record

Claim 20 depends from claim 19 and defines a key frame marker for inserting index markers in said digital data marking abrupt changes in video image sequences, and alternatively, at selectable time intervals. Tognazzini is directed to the recording of a program or a scene from the beginning, after the program or scene has started. Tognazzini does not insert index markers into the digital data. Therefore, the Appellant respectfully assert that for the above reasons claim 20 is patentable over the 35 U.S.C. § 103(a) rejection of record.

B. Conclusion

For the reasons advanced above, Appellant respectfully submits that claims 1-20 are patentable over the rejections under 35 U.S.C. § 103(a). Therefore, reversals of the rejections are courteously solicited.

IX. CLAIMS INVOLVED IN THE APPEAL

A copy of the claims involved in the present appeal is attached hereto as Appendix A.

The fee for filing the Appellant's Brief is figured on the Transmittal Sheet. The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) or credit any overpayment to Deposit Account No. 08-2025, under Order No. 10981001-1, from which the undersigned is authorized to draw.

Dated: April 13, 2004

Respectfully submitted,

By

Christopher S.L. Crawford
Registration No.: 51,586
Attorney for Applicant.

(214) 855-8378

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482736427US, in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: April 13, 2004

Signature:

Christopher S.L. Crawford

APPENDIX A

Claims Involved in the Appeal of Application Serial No. 09/368,792

1. (Previously Presented) Apparatus for converting analog video data into digital form, the apparatus comprising:

an analog video cassette player for producing analog video output;

an analog to digital converter for converting said analog video output into digital data;

at least one recorder employing a digital storage medium for storing said digital data, wherein said cassette player, said at least one converter and said storage medium are disposed within a single container; and

a key frame marker for inserting at least one marker into the digital data.

2. (Original) The apparatus of claim 1, further comprising:

a video port for receiving analog video information from an external source.

3. (Original) The apparatus of claim 1, wherein the video cassette player employs a VHS format.

4. (Original) The apparatus of claim 1, wherein the digital storage medium is one of a CD-R or a CD-RW.

5. (Original) The apparatus of claim 1, wherein the digital storage medium is a recordable DVD.

6. (Original) The apparatus of claim 1, wherein the digital storage medium is selectable by the user.

7. (Previously Presented) The apparatus of claim 1, wherein the key frame marker marks abrupt changes in video image sequences, thereby enabling a user to readily locate a beginning and an end of a particular video sequence.

8. (Previously Presented) The apparatus of claim 1, wherein the key frame marker marks positions in a sequence of said digital data at selectable time intervals.

9. (Original) The apparatus of claim 1, wherein the video cassette player employs the 8 mm format.

10. (Original) A method for preserving analog video data in digital form, the method comprising the steps of:

producing analog video output from an analog video tape;

converting said analog video output into digital video data;

storing said digital video data in a non-volatile digital storage medium thereby protecting said data against degradation over time; and

providing a single container to perform the steps of producing, converting, and storing.

11. (Original) The method of claim 10 comprising the further step of:

determining a required digital storage format prior to said step of converting based upon detection of a format of an inserted storage medium.

12. (Original) The method of claim 10 comprising the further step of:

inserting at least one marker in said digital video data to identify abrupt changes in video scenery, thereby enabling a user to readily identify particular video sequences during playing of said digital video data.

13. (Original) The method of claim 10, comprising the further step of:

inserting at least one marker in said digital video data at selectable time intervals, thereby enabling a user to readily move to selected chronological points in a video sequence during playing of said digital video data.

14. (Original) The method of claim 10, wherein the digital storage medium is one of CD-R or CD-RW.

15. (Original) The method of claim 10, wherein the digital storage medium is a recordable DVD.

16. (Original) The method of claim 10, wherein the digital storage medium is digital tape.

17. (Original) The method of claim 10, wherein the analog video tape is in VHS format.

18. (Original) The method of claim 10, wherein the analog video tape is in 8 mm format.

19. (Original) Apparatus for preserving analog video data in digital form, the apparatus comprising:

a video cassette player for producing analog video output;

an analog to digital converter for converting said analog video output into digital data thereby protecting said data against degradation of over time; and

one of a CD recorder and a DVD recorder for storing said digital data, wherein said video cassette player, said analog to digital converter, and said digital storage medium are disposed within a single container.

20. (Original) The apparatus of claim 19, further comprising:

a key frame marker for inserting index markers in said digital data marking abrupt changes in video image sequences, and alternatively, at selectable time intervals.